REMARKS

Claims 1-23 are pending in the present application. Claims 1 and 14 are independent claims.

I.   DRAWING OBJECTION

The drawings corrections filed on February 4, 2002 have been disapproved because Figs. 1-5B are not designated by a legend such as "Prior Art". This objection is respectfully traversed.

Applicant respectfully submits that the suggestion in MPEP § 608.02(g) of the use of the phrase --Prior Art-- does not exclude the use of alternate phrases, for example, "Background Art" and "Conventional Art". These alternative phrases may be found in many U.S. Patents issued today. The intent of MPEP § 608.02(g) is to distinguish Applicant's invention from that which is not Applicant's invention. If a drawing illustrates only material which is known to be statutory prior art to the invention, then the use of the phrase --Prior Art-- in the drawings may be proper. However, if it is not clear whether such material is statutory prior art, then the use of the phrase --Prior Art-- in the drawings would be improper, but rather, a label such as "Background Art" or "Conventional Art" would be more appropriate.

Applicant submits that the drawings including the label "Background Art" meet the criteria of MPEP § 608.02(g) and are sufficient to distinguish Applicant's

invention from that which is not Applicant's invention, since it is uncertain whether Figs. 1-5B qualify as prior art under 35 U.S.C. § 102. Accordingly, reconsideration and withdrawal of this objection based on these reasons are respectfully requested, and the approval of the drawing corrections filed on February 4, 2002 is also respectfully requested.

II.   **OBJECTION TO SPECIFICATION**

The Amendment filed on February 4, 2002 has been objected to under 35 U.S.C § 132 because the Examiner alleges that it introduces new matter into the disclosure.

Although Applicant disagrees with the Examiner that the previously added material is not supported by the original disclosure, to expedite prosecution, such amendments are removed. Instead, the specification has been amended to specify that the location information is reset to a predetermined reset value. This is fully supported by the original disclosure, e.g., page 12, line 12 - page 13, line 1 of the original specification where resetting of the location information to a certain reset value is discussed. The current amendments do not introduce any new matter to the original disclosure. Accordingly, entry of the present amendments is deemed proper and respectfully requested.

III.   35 USC § 112, FIRST PARAGRAPH, REJECTION

Claims 1-13 and 20-21 have been rejected under 35 U.S.C § 112, first paragraph, as allegedly containing subject matter which was not described in the specification at the time the application was filed. Without acquiescing to any of the Examiner's allegations made in connection with this rejection, in view of the cancellation of the objected material, this rejection is moot and reconsideration and withdrawal of the rejection based on these reasons is respectfully requested.

IV.   35 USC § 102 AND 103 REJECTIONS

Claims 14-19 have been rejected under 35 U.S.C § 102(b) as being anticipated by *Bish et al.* (U.S. Patent No. 5,235,585). Claims 22-23 have been rejected under 35 U.S.C § 103(a) as being unpatentable over *Bish et al.* as applied to claims 14-19 above. These rejections, insofar as they may pertain to the presently pending claims, are respectfully traversed.

Regarding independent claim 14, the Examiner alleges that *Bish et al.* discloses the step of resetting location information of a supplementary spare area and cites column 6, lines 13-24 and column 6, lines 62-column 7, line 6 of *Bish et al.* to support his position. Applicant has carefully reviewed the entire *Bish et al.* reference including the portions specifically cited by the Examiner. However, *Bish et al.* including the cited portions, teaches a secondary defect list and

replacing secondary defects with the first available spare sector in the first available group. *Bish et al.* is absolutely silent on <u>resetting the stored location information of a supplementary spare area to a predetermined reset value in response to a formatting request</u> as in Applicant's claimed invention. For example, as shown in Figure 6 of the present application, in step 603, in response to a formatting command at step 601, the location information (e.g. start and end addresses) of a supplementary spare area recorded on the recording medium is reset to a predetermined reset value to erase any previously stored information. As a result, when the defects registered in an old SDL are moved to a new PDL during the formatting process, consistent defect information can be provided and accessed by both a driver and a file system and other drivers can access the consistent defect information. This is not a concern that is addressed at all by *Bish et al.* since *Bish et al.* is merely concerned with quickly locating a replacement spare sector for secondary defects using certain equations as set forth column 7, lines 55-59, 65-67 and column 8, lines 12-30.

Therefore, *Bish et al.* fails to teach or disclose, *inter alia*:

> Resetting the location information stored on the recording medium to a predetermined reset value in response to the instruction

as recited in independent claim 14.

In the alternative, regarding claim 17, the Examiner alleges that *Bish et al.* discloses registering all sectors previously registered in an old SDL into a new

PDL, as required by dependent claim 17. Applicant has carefully reviewed the portions of *Bish et al.* cited by the Examiner to support this position and respectfully submits that these portions of *Bish et al.* teach registering replacement sectors in a replacement sector list, and not registering sectors registered in an old SDL into a new PDL, which is part of a formatting process of Applicant's invention.

Further, there is no motivation to modify *Bish et al.* to render the claimed invention obvious because *Bish et al.* is not at all concerned with (1) inconsistencies created during a reformatting process of a recording medium between a driver and a file system and (2) incompatible recording by different drivers.

Therefore, the invention as recited in independent claim 14 and its dependent claims is patenable over *Bish et al.*, and reconsideration and withdrawal of the rejection based on these reasons is respectfully requested.

CONCLUSION

For the foregoing reasons and in view of the above clarifying amendments, Applicant respectfully requests the Examiner to reconsider and withdraw all of the objections and rejections of record, and earnestly solicits an early issuance of a Notice of Allowance.

The Examiner is respectfully requested to enter this Amendment After Final Rejection, in that it raises no new issues but merely places the claims in a form more clearly patentable over the references of record. In the alternative, the Examiner is respectfully requested to enter this Amendment After Final Rejection in that it reduces the issues for appeal.

Should there be any outstanding matters which need to be resolved in the present application, the Examiner is respectfully requested to contact Esther H. Chong (Registration No. 40,953) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Amendment.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP
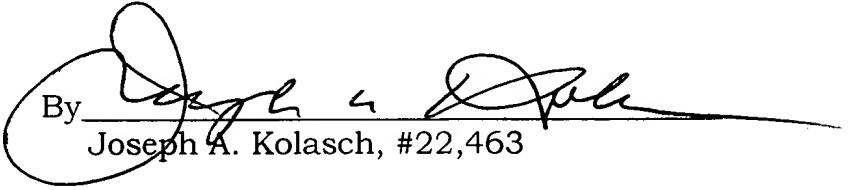
By_____
Joseph A. Kolasch, #22,463

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Attachment

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

The paragraph beginning on page 12, line 8 has been amended as follows:

-- Referring to Fig. 6, upon receiving a formatting command (step 601), a judgement is made if a supplementary spare area has been assigned (step 602). If the supplementary spare area assignment exists, the location information of the supplementary spare area recorded in the DMA is reset (step 603) to a predetermined reset value [an initial or nullified state]. To reset the location information of the supplementary spare area, any one of a variety of methods may be utilized. In one example, all the location information values of the supplementary spare area may be converted to a predetermined reset value which may be the lowest value (for example, 00h) or the highest value (for example, FFh), thereby erasing [nullifying] any previously stored address information. In another example, the location information may be converted into a specific code value according to a predetermined agreement. That is, the location information value may be converted to a predetermined reset value which would allow the file system to recognize that the location information of the supplementary spare area has been reset when the file system receives the DMA information from the driver.--

IN THE CLAIMS:

The claims have been amended as follows:

1. (Twice Amended) A method of formatting an optical recording medium stored therein with location information of a supplementary spare area, the method comprising:

(a)   resetting the stored location information of the supplementary spare area to a <u>predetermined reset value</u> [nullified state] in response to a formatting request; and

(b)   formatting the optical recording medium in response to the formatting request.

3. (Twice Amended) A method of claim 1, wherein said resetting step (a) comprises converting the location information of the supplementary spare area to <u>the</u> [a] predetermined <u>reset</u> value<u>, thereby erasing any previously stored location information</u> [which indicates that the location information of the supplementary spare area has been reset to the nullified state].

14. (Amended) A method of formatting a recording medium, the recording medium storing therein location information of a supplementary spare area, the method comprising:

receiving an instruction to format the recording medium;

resetting the location information stored on the recording medium <u>to a</u> <u>predetermined reset value</u> in response to the instruction; and

transferring secondary defect information with a new PDL (primary defect list) to format the recording medium according to the instruction.

20. (Amended) A method of claim 14, wherein the resetting step includes the step of:

converting the location information of the supplementary spare area to <u>the</u> [a] predetermined <u>reset</u> value<u>, thereby erasing any previously stored location</u> <u>information</u> [that indicates that the location information of the supplementary spare area has been reset to a nullified state].